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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,850	02/18/2004	Hideyuki Kubota	Q79919	9443

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EXAMINER

FALASCO, LOUIS V

ART UNIT PAPER NUMBER

1773

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,850

Applicant(s)

KUBOTA, HIDEYUKI

Examiner

Louis Falasco

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/18/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

PAPERS RECEIVED

The Information Disclosure Statement filed 2/18/04 is acknowledged.

The Election filed 12/23/05 are acknowledged.

CLAIMS

The claims are: 1 to 3

Election/Restriction of Invention

1. Applicant's election without traverse of Group I (claims 1 and 2) in the reply filed on 12/23/05 is acknowledged.
2. Claim 3 is withdrawn from further consideration, as being drawn to a nonelected invention.

Claim Rejections - 35 U.S.C. §112

Statutory Basis

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 recites the limitation "the entire area" in the fourth sub paragraph. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 U.S.C. §102 and 35 U.S.C. §103

Statutory Basis

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Nagao et al** (US Patent 6759183)

Nagao et al teaches a master information carrier of a substrate having a pattern of protrusions and recesses corresponding to information to be transferred to a slave medium and a magnetic layer formed on substrate protrusions and recesses, where the magnetic layer on the pattern has a protective coating (see Fig. 2 and example 5).

Alternate to anticipation: if there is a difference between what has been claimed and **Nagao et al**, it is in the recitation of a characteristic free energy for the protective coating, specifically 57 mN/m-69 mN/m. However this would have been inherent in the protective coat of since **Nagao et al** teaches the coating as composed of DLC (Diamond-Like Carbon), within the 2 nm to 30 nm thickness as applicants' disclose (*cf* **Nagao et al** DLC protective layer item 34 of Fig. 2, and the 5 nm thickness in Example 5 and col. 13 ln 13 with **instant specification** at page 10 lns 3-5, 7, 8) for this energy characteristic. The claimed energy for the protective coating it would have been anticipated or, in the alternative, at least been obviously inherently present in **Nagao et al** since **Nagao et al** teaches forming the protective coating of the same DLC material with the same thickness dimension¹.

¹ The claiming of an unidentified property appearing inherently present does not necessarily make a claim patentable. Where claimed and prior art products have been shown to be substantially identical in structure or composition or produced by identical processes and a case of anticipation or prima facie obviousness has been established the burden of proof shifts to applicant to show prior art products do not necessarily nor inherently possess the characteristic of the claimed product - see *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

5. Claims 1 and 2 are rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Saito et al** (US 6613459).

Saito et al teaches a master information carrier for magnetic transfer having a substrate of a pattern of protrusions and recesses and a magnetic layer formed on the protrusions and recesses, where the magnetic layer has a protective coating (see Fig. 8 layer 32, and col. 10 lns 59, 60). If there is any difference between what have been claimed and **Saito et al** it is in not enumerating a free energy, specifically the instant claimed 57 mN/m-69 mN/m characteristic free energy for the protective coating. This characteristic is disclosed as from a DLC with thickness between 2 nm to 30 nm, preferably 3 nm to 10 nm thick coated in decreased Argon gas flow (from instant specification page 10 lns 3-5, 7, 8). Alternate to anticipation by **Saito et al**, the 57 mN/m-69 mN/m characteristic free energy for the protective coating would have at least been inherent since, like applicants Ar gas flow is decreased in the **Saito et al** process (see decrease in Argon gas by addition of other gasses at col. 10 lns 59-68) and **Saito et al** teaches a DLC thickness between 3 nm to 10 nm (**Saito et al** 50 Å i.e., 5 nm at col. 11 ln 14, 15). **Saito et al** DLC protective coating appears of the same dimension and product of the same process as applicants' consequently the 57 mN/m-69 mN/m range it would have been anticipated at least been obviously inherently present.

OTHER REFERENCES

Kamatani et al (US 6906875) and **Nishikawa et al** (US 6909563) are cited as being of interest both teaching a master information carrier for magnetic transfer having a substrate with protrusions and recesses corresponding to information to be transferred to a slave medium, where the magnetic layer on the pattern of protrusions and recesses has a DCL protective coating, cumulative to **Nagao et al** and **Saito et al**.

CONCLUSION

The claims are 1 to 3.

- Restriction has been required and claim 3 has been withdrawn from consideration, as being drawn to a non-elected invention.
- No claim has been allowed.
- Information Disclosure Statement has been received.

INQUIRES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Falasco, PhD whose telephone number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney, PhD can be reached at (571)272-1284. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LF
03/06


CAROL CHANEY
SUPERVISORY PATENT EXAMINER